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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,227	08/24/2001	David Eugene Hirth	D5407-25	4072

7590 06/05/2003

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EXAMINER

TSAY, FRANK

ART UNIT

PAPER NUMBER

3672

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.  
09/939,227

Applicant(s)

Hirth

Examiner

Frank Tsay

Art Unit

3672

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Mar 7, 2003
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6 and 15-20 is/are allowed.
- 6) ☒ Claim(s) 7 and 21-36 is/are rejected.
- 7) ☒ Claim(s) 8-14 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

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***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 7 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by O'Brien '070.

O'Brien discloses a circulating and pressure equalizing sub which comprises all of the claimed structure shown in Figs. 2 and 3. More specifically, the "seat" is met by the ball seat 60 which is supported by a movable body 32. The seat is adapted to receive a member or ball 80 thereon to obstruct the tubular for pressure build-up. The claimed first position is met by Fig. 2, and the second position is met by Fig. 3. The movement-regulation device is anticipated by the shear pin 56 which yields until a predetermined fluid pressure is applied. The housing and the chamber fail to structurally distinguish from tubular structure 10 and the internal space located near the seat assembly shown in the respective drawings.

***Claim Rejections - 35 USC § 251***

2. Claims 21-36 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPO 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject

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matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

In view of the applicant's original prosecution, Claims 1 and 13 (15 in Patent) had a limitation added, Claims 3 (6 in Patent), 5 (7 in Patent), 14 (17 in Patent), 16 (18 in Patent), 17 (19 in Patent) and 20 were rewritten in independent forms, and thus the limitations those dependent claims had, made the resulting independent claims patentable. Therefore any claim in the reissue application that fails to have at least one of these limitations is considered recaptured of surrendered subject matter under 35 USC § 251.

### ***Response to Arguments***

3. Applicant's arguments filed March 7, 2003 have been fully considered but they are not persuasive. Specifically, with respect to claim 7, applicant argues that O'Briens shear pin 56 can not be operable on the seat assembly to selectively regulate movement from the first to the second position because it simply **shears or fails quickly**. Examiner disagrees with such assertion in that, the claimed limitation of Claim 7 only calls for a movement regulating device which controls the movement of the seat assembly from the first to the second position, whether it controls the movement from the first position to the second position instantaneously or in a controlled rate has never been an issue. The movement of the seat assembly from the first position to the second position is clearly demonstrated in Figs 2 and 3, since any position differs from the first position

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(Fig 2) can be defined as a second position (Fig. 3). With respect to the question of why claim 1 is allowable while claim 7 isn't. Applicant is advised to read further into the claim limitation set forth in claim 1, where the movement regulating device is specifically defined as being operable on said seat assembly to selectively regulate **the rate** of movement, while claim 7 only calls for regulating of the movement of the seat assembly. Rejection of Claims 21-36 under 35 USC 251 on the ground of recapture, examiner believes he has clearly explained his position in the office action and no further response is needed.

***Allowable Subject Matter***

4. Claims 1-6, and 15-20 are allowed.
5. Claims 8-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Frank S. Tsay whose telephone number is (703) 308-2170. The examiner can normally be reached on Monday through Friday from 8:30 A.M. to 4:00 P.M. E.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. David Bagnell, can be reached on (703) 308-2151. The fax phone number for this Group is (703)305-3597, (703) 305-7687, or (703) 306-4195.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-2168.

Tsay/FT

June 4, 2003

